

REMARKS

Summary of Office Action

Claims 1-9, 13-17, 19-20, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Claim 24 was rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner rejected claims 1-6, 9, 13, 15, 19-20 and 24 under 35 U.S.C. § 102(b) as being anticipated by Oxley U.S. Patent No. 1,147,041 (hereinafter, "Oxley").

The Examiner rejected claims 1-6, 9, 13, 15, 20, 24 and 26 under 35 U.S.C. § 102(b) as being anticipated by Morris U.S. Patent No. 4,432,151 (hereinafter, "Morris 1") as well as by Morris U.S. Patent No. 4,505,059 (hereinafter, "Morris 2").

Claims 1, 3, 5, 9, 15, 19, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Pichereau U.S. Patent No. 417,082 (hereinafter, "Pichereau").

The Examiner rejected claims 1-6, 9, 13-17, 19-20, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Barhite U.S. Patent No. 746,264 (hereinafter, "Barhite") in view of Dorney U.S. Patent No. 6,062,380 (hereinafter, "Dorney") and Greiner U.S. Patent No. 6,253,918 (hereinafter, "Greiner").

Claims 1-6, 9, 13, 15, 20, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Wooster U.S. Patent No. 242,805 (hereinafter, "Wooster") in view of Dorney and Greiner.

The Examiner rejected claims 7-8 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Wooster in view of Dorney and Greiner, and further in view of Hepburn U.S. Patent No. 4,927,041 (hereinafter, "Hepburn").

Claims 7-8 and 14 were also rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Morris 1 or Morris 2 in view of Hepburn.

Claim 14 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Oxley.

The Examiner rejected claims 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Morris 1 or Morris 2 in view of Barhite.

Summary of Applicant's Response

Applicant has amended claims 1 and 26 to further distinguish applicant's claimed invention over the prior art.

In accordance with the Examiner's suggestions, claim 24 has also been amended by applicant.

The Examiner's rejections are respectfully traversed.

Reconsideration of this application in light of the following remarks is respectfully requested.

Introduction

With regards to the rejections of the claims under 35 U.S.C. § 103(a), applicant respectfully maintains the position set forth in the November 15, 2002 Reply to Final Office Action (hereinafter, "Reply") and the December 9, 2002 Preliminary Amendment (hereinafter, "Preliminary Amendment") that, contrary to the Examiner's assertion, none of the prior art cited by the Examiner, including Barhite, Wooster, Dorney, Hepburn, and Greiner, alone or in combination, make applicant's claimed invention obvious in any manner. Moreover, applicant respectfully submits that the additional prior art cited by the Examiner, including Morris 1, Morris 2, Oxley and Pichereau, alone or in combination with any of the cited prior art, still

does not make applicant's claimed invention obvious in any manner.

Furthermore, while applicant acknowledges that the Examiner has set forth new grounds of rejection under 35 U.S.C. § 102(b) based on the newly cited prior art, applicant respectfully submits that the Examiner has nonetheless failed to address applicant's arguments set forth in the Reply and the Preliminary Amendment Reply pertaining to the reasons why none of the prior art renders applicant's claimed invention obvious. In accordance with page 700-99 of the Manual of Patent Examining Procedure, 8th edition (hereinafter, "MPEP"), even when arguments are considered moot because of new grounds of rejection (although the Examiner has not even identified applicant's prior arguments as moot), "[t]he Examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied." Applicant respectfully submits that many of applicant's arguments submitted in the Reply and the Preliminary Amendment remain relevant to the Examiner's current rejections under 35 U.S.C. § 103(a), yet were not addressed by the Examiner (in fact, the current Office Action does not acknowledge the Preliminary Amendment, including applicant's proposed drawing

change submitted therewith, that was filed shortly after the December 3, 2002 Examiner Interview). Accordingly, applicant respectfully submits below further arguments to those presented in the Reply and the Preliminary Amendment.

Applicant's Response to the Rejection
Under 35 U.S.C. § 112, first paragraph

Claims 1-9, 13-17, 19-20, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Applicant respectfully traverses the rejection under 35 U.S.C. § 112, first paragraph.

The Examiner stated that "[t]ranslucent is defined as transmitting light but causing sufficient diffusion to prevent perception of distinct images" (although no source was provided), and that a label placed within applicant's label container area cannot be read because "the translucence of the outer wall would distort the image to prevent perception" (Office Action, page 2).

Applicant respectfully submits that, according to the guidelines set forth on page 2100-48 of the MPEP, applicant "may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage" and as long as the meaning of the term is "sufficiently clear in the specification." Applicant's specification, as originally filed, clearly explains that a translucent material is to be used such that "users can easily read the writing on [a] label without having to open [a lid] to read the label" (specification, page 8, lines 16-18). Therefore, "translucent" is adequately defined under 35 U.S.C. § 112, first paragraph, to enable one skilled in the art to make and/or use the invention.

Moreover, as defined on page 1255 of the Merriam Webster's Collegiate Dictionary, 10th edition, the term translucent refers to the characteristic of "permitting the passage of light." Translucent is further defined to mean, among other things, "clear, transparent" (the example provided being transparent water). Given these definitions, and the fact that the Examiner suggested modifying the prior art such that an outer wall is made "translucent or transparent in order to see an item" through the outer wall (Office Action, page 4),

it should be evident that the meaning assigned by applicant to the term translucent is not repugnant to the term's well known usage.

For at least these reasons, applicant's originally filed specification is sufficient under 35 U.S.C. § 112, first paragraph to enable one skilled in the art to make and/or use applicant's claimed invention. Therefore, applicant respectfully requests that the rejection of the claims under this section be withdrawn.

Applicant's Response to the Rejection
Under 35 U.S.C. § 112, second paragraph

Claim 24 was rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 24 in accordance with the Examiner's suggestions in order to more particularly point out and distinctly claim the subject matter which applicant regards as the invention.

No new matter has been added by this amendment. Support for this amendment may be found, for example, in

applicant's originally filed specification, page 9, line 31 to page 10, line 15.

Applicant's Response to the
Rejection Under 35 U.S.C. § 102(b)

Claims 1-6, 9, 13, 15, 19-20, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by at least one of Morris 1, Morris 2, Oxley and Pichereau.

Applicant respectfully traverses the rejections of the claims under this section.

Claims 1-6, 9, 13, 15, 19-20 and 24

The Examiner rejected claims 1-6, 9, 13, 15, 19-20 and 24 under 35 U.S.C. § 102(b) as being anticipated by Oxley.

The rejection is respectfully traversed by applicant.

Applicant's invention is directed toward a food storage unit that includes a container (inside which food may be stored) having a fixably sealed lid and a channel region that is formed between an inner and an outer wall. This channel region, in accordance with the principles of the present invention, includes an accessible label container area, with a label support member, in which a user may insert

identifying labels. Accordingly, identifying labels may be used to provide information regarding the contents of the food storage container such that a user is able to read the identifying label of the food storage container without having to open the container (i.e., remove the lid) or remove the container from a cooling unit in which it is being housed. Moreover, the label remains protected from the effects of the environment inside the cooling unit.

Oxley merely seeks to provide a display box D that has a front portion (in which foods may be placed on shelves for display) that is separated by a back partition F, behind which food contents are placed that may be sold or removed without affecting the appearance of the foods located in the front portion. Unlike applicant's claimed invention, however, Oxley does not show or suggest any manner in which an identifying label may be placed in the front portion such that a user can read the label without having to remove the label from the display box D. Rather, Oxley suggests placing items, such as cans of food, inside the front portion (i.e., the spacing between Oxley's glass window E and backing partition F). Therefore, given the amount of spacing inside Oxley's front portion, a label placed between glass window E and backing

partition F would not remain in an upright position, thereby prohibiting the label to be read without first being removed. Moreover, Oxley does not describe or suggest a lid that may be used to "seal" the box "CLOSED" (e.g., to prevent the spoilage of food) as does applicant's claimed lid member. In fact, Oxley never even suggests the possibility of storing perishable items within display box D, in which case a lid capable of sealing CLOSED display box D would be desirable.

Nevertheless, to expedite prosecution of this application, applicant has amended independent claims 1 and 26 to include the limitation that the inner and outer wall have a "fixed geometric relationship" to further distinguish applicant's claimed invention over the prior art. This limitation is clearly not taught or suggested in Oxley, in which the backing partition F (i.e., the inner wall of Oxley) must be removed in order for a user to be able to place any item between glass window E and backing partition F. Similarly, the added limitation to claim 1 that applicant's label support member is "physically attached to said inner and outer walls" is also clearly not taught or suggested by Oxley.

For at least the above reasons, applicant respectfully submits that independent claim 1, as amended, is

allowable over Oxley. Therefore, applicant respectfully requests that the rejection of claim 1, in addition to the rejection of claims 2-6, 9, 13, 15, 19-20, and 24 which depend from claim 1, be withdrawn.

Claims 1-6, 9, 13, 15, 20, 24 and 26

The Examiner rejected claims 1-6, 9, 13, 15, 20, 24 and 26 under 35 U.S.C. § 102(b) as being anticipated by both Morris 1 and Morris 2.

Applicant respectfully traverses the Examiner's rejection.

Similar to Oxley, applicant respectfully submits that neither Morris 1 nor Morris 2 shows applicant's claimed invention. Rather, Morris 1 and Morris 2 are merely advertising display apparatus that may be used to display, for example, business cards. Neither Morris 1 nor Morris 2 seeks to provide a food storage container such as applicant's claimed invention. In fact, neither Morris 1 nor Morris 2 discusses the possibility or desirability for storing food within the advertising display apparatus (i.e., the respective display means 20 of Morris 1 and Morris 2).

Furthermore, the invention defined by applicant's independent claims 1 and 26, as amended, is not shown or suggested for at least the reason that neither Morris 1 nor Morris 2 shows or suggests an inner and outer wall having a "fixed geometric relationship." Rather, the respective support sections 41 and display sections 46 of Morris 1 and Morris 2 are only accessible for the insertion of advertisements after the inner walls that serve to press the advertisements against the outer wall are removed. Moreover, neither Morris 1 nor Morris 1 show or suggest applicant's claimed label support member as defined in amended claim 1 that is physically attached to both an inner and outer wall.

For at least these reasons, applicant respectfully submits that independent claims 1 and 26, as amended, are allowable over both Morris 1 and Morris 2, as are claims 2-6, 9, 13, 15, 20, and 24 which depend from claim 1.

Claims 1, 3, 5, 9, 15, 19, 24 and 26

Claims 1, 3, 5, 9, 15, 19, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Pichereau.

Applicant respectfully traverses the rejection of the claims under this section.

Pichereau describes an improved inkstand having "several inclined-bottom ink-troughs about a central cup" (Pichereau, column 1, lines 27-28). Pichereau does not, however, show or suggest applicant's claimed invention of a food storage unit for storing food including applicant's label container area as described above.

The bottom portion (j) of the sponge-cup located in the center of Pichereau's sponge-cup cover, which acts as an axle allowing the sponge-cup cover to be rotated, is inserted into the central cup of the inkstand. Accordingly, neither food, ink, or anything else may be placed or stored inside Pichereau's central cup while the sponge-cup cover is being used. Accordingly, applicant's invention is not anticipated by Pichereau, because anything to be stored must be located between Pichereau's inner and outer walls, preventing this same region from being occupied by an identifying label. For example, persons skilled in the art will appreciate that placing a label together with ink being stored would destroy the label.

Moreover, applicant respectfully submits that applicant's claims 1 and 26 are not anticipated by Pichereau because Pichereau's sponge-cup cover includes "a slot in the outer edge of [the] rim [that] provides a dipping-hole" such that a pen may be dipped in ink that is located within one of the "inclined-bottom ink-troughs." Clearly, this is an admission by Pichereau that the sponge-cup cover is not capable of sealing the inkstand CLOSED, and thus, Pichereau is structurally different from applicant's claimed invention.

Therefore, applicant respectfully submits that independent claims 1 and 26, as amended, are allowable over Pichereau, as are claims 3, 5, 9, 15, 19, and 24 which depend from claim 1.

For at least the foregoing reasons, applicant respectfully submits that none of the references relied upon by the Examiner, including Morris 1, Morris 2, Oxley and Pichereau, render applicant's claimed invention unpatentable. Therefore, applicant respectfully requests that the rejections of claims 1-6, 9, 13, 15, 19-20, 24 and 26 under this section be withdrawn.

Applicant's Response to the
Rejection Under 35 U.S.C. § 103(a)

Claims 1-9, 13-17, 19-20, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 102(b) as being unpatentable over various combinations of Barhite, Dorney, Greiner, Hepburn, Morris 1, Morris 2, Oxley and Wooster.

Applicant respectfully traverses the rejections of the claims under this section.

Claims 1-6, 9, 13-17, 19-20, 24 and 26

The Examiner rejected claims 1-6, 9, 13-17, 19-20, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Barhite in view of Dorney and Greiner.

The rejection under this section is respectfully traversed by applicant.

The Examiner stated that it would have been obvious to modify "the outer wall of Barhite to be either translucent or transparent in order to see an item placed within the space between the inner and outer walls" (Office Action, page 4). Applicant respectfully submits that such a modification would not "teach or suggest all the claim limitations" as required by the MPEP (see MPEP, page 2100-121).

As set forth in the Reply and the Preliminary Amendment, Barhite merely discloses a cream separator comprising an inner shell or milk-receptacle 10, a surrounding shell or water-receptacle 14, an annular cover 20 and a secondary cover 23. Cold water is introduced into the water-receptacle 14 to cool the contents of milk-receptacle 10, for the purpose of producing cream. In comparison with the present invention, however, Barhite lacks more than simply a translucent out wall, for at least the reason that Barhite does not include a label container area for the insertion of a label therein.

Given that the Examiner has not specifically identified the manner in which Barhite discloses applicant's claimed invention "except for the translucent/transparent outer wall," applicant must assume that the Examiner equated Barhite's water-receptacle 14 with applicant's claimed label container area. Applicant, however, respectfully submits that any label placed into water-receptacle 14 would be destroyed by the water therein, and therefore, that water-receptacle 14 is not the same as applicant's claimed label container area.

Additionally, there simply is no suggestion anywhere in Barhite to make the modification suggested by the Examiner

(i.e., to make the outer wall of Barhite translucent), or for water-receptacle 14 to be empty of water. In fact, if water-receptacle 14 was empty of water or some other cooling agent, the production of cream would not be possible and there would be no invention to speak of. Thus, the Examiner's proposed modification of replacing the outer wall of water-receptacle 14 with a translucent material so that labels placed therein could be viewed teaches away from the essence of what Barhite's patent is for. Therefore, the suggestion that it would have been obvious to modify Barhite to make water-receptacle 14 void of water or another cooling agent such that the water-receptacle 14 could serve a similar function as applicant's label container area is simply not supported by Barhite's disclosure. MPEP, page 2100-124 ("[i]f proposed modification would render the prior invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification").

Moreover, as previously explained in the Preliminary Amendment, Barhite explains the desirability of having minimal exposure "of the surface of the inner receptacle ... so that there will be a minimum of loss from radiation" (Barhite, column 1, line 49 to column 2, line 1, emphasis added).

Clearly, replacing the water-container 14 with a translucent material renders the milk-receptacle 10 vulnerable to radiation (e.g., sunlight or an artificial source of light), and thus, Barhite specifically teaches against the use of a translucent outer wall. It is not reasonable, therefore, to assume that such a modification as suggested by the Examiner would have been obvious at the time the invention described by Barhite was made. Rather, the requisite "motivation to combine" is clearly lacking, and therefore, the Examiner's rejection should be withdrawn. MPEP, page 2100-124 ("[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination").

For at least the foregoing reasons, applicant respectfully submits that each of claims 1-6, 9, 13-17, 19-20, 24 and 26 are patentable under 35 U.S.C. § 103(a) over any combination of Barhite, Dorney and Greiner.

Claims 1-6, 9, 13, 15, 20, 24 and 26

Claims 1-6, 9, 13, 15, 20, 24 and 26 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Wooster in view of Dorney and Greiner.

Applicant respectfully traverses the Examiner's rejection.

Contrary to the Examiner's statement that "[i]t would have been obvious to modify the material of the outer wall of Wooster to be translucent or transparent in order to see an item placed within the space between the inner and outer walls of a container" (Examiner's Action, pages 3-4), applicant respectfully submits that the disclosure of Wooster, like Barite, is inadequate to support the Examiner's suggestion of obviousness.

Wooster discloses a milk cooler that includes a cabinet A with a hinged lid B and a door C. A partition D is set in the cabinet, having a central perforation E, into which an elongated milk-receptacle F is placed in a water tight manner. The upper region of the cabinet separated by partition D is lined with sheet metal to form ice-receptacle G. Ice and cold water is introduced into the ice-receptacle G to cool the contents of milk-receptacle F, for the purpose of extracting cream.

Wooster fails to show or suggest replacing the outer wall, which is "preferably made of wood" (Wooster, column 1, lines 21-22), with a translucent material. Moreover, Wooster

simply does not show or suggest applicant's label container area. In fact, placing a label within Wooster's ice-receptacle G, which the Examiner has apparently equated with applicant's label container area, would result in the destruction of any such label because ice-receptacle G is a receptacle for ice and cold water. Similar to Barhite, the proposed modification of Wooster (i.e., replacing ice-receptacle with a dry label container area) would eviscerate the essence of Wooster's invention. Moreover, the central chamber of Wooster would be subjected to undesirable radiation that could significantly reduce the effectiveness of Wooster's apparatus if the outer wall was made translucent or transparent.

Applicant therefore respectfully submits that Wooster fails to provide the requisite suggestion to modify and, if fact, teaches away from such a modification. Absent such a suggestion, it is improper to classify this type of modification as obvious. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) ("identification in the prior art of each individual part claimed is insufficient ... there must be some motivation, suggestion or teaching of the

desirability of making the specific combination that was made by the applicant").

In light of the above, applicant respectfully submits that each of claims 1-6, 9, 13, 15, 20, 24 and 26 are patentable under 35 U.S.C. § 103(a) over any combination of Dorney, Greiner and Wooster.

Claims 7-8, 14, 16, and 17

Claims 7-8, 14, 16 and 17 were also rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Barhite, Dorney, Greiner, Hepburn, Morris 1, Morris 2, Oxley and Wooster.

The rejections are respectfully traversed by applicant.

For at least the foregoing reasons, applicant's independent claims 1 and 26, as amended, are allowable over any combination of the prior art cited by the Examiner. Accordingly, each of claims 7-8, 14, 16 and 17, which depend either directly or indirectly from claims 1, are allowable as well.

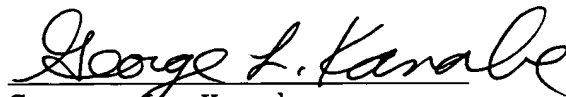
For at least the foregoing reasons, applicant respectfully submits that none of the references relied upon by

the Examiner, including Barhite, Dorney, Greiner, Hepburn, Morris 1, Morris 2, Oxley and Wooster, alone or in combination, render applicant's claimed invention unpatentable. Therefore, applicant respectfully requests that the rejections of claims 1-9, 13-17, 19-20, 24 and 26 under this section be withdrawn.

Conclusion

For at least the reasons stated above, applicant respectfully submits that this application, including each of claims 1-9, 13-17, 19-20, 24 and 26, is in condition for allowance. Reconsideration and a favorable action are respectfully requested.

Respectfully submitted,



George L. Kanabe
Reg. No. 51,858
Agent for Applicant
FISH & NEAVE
Customer Number 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000
Fax: (212) 596-9090

APPENDIX A

AMENDED CLAIMS
MARKED TO SHOW AMENDMENTS

1. (amended) A food storage unit, comprising:
a container comprising a container top, a container bottom, an inner wall and an outer wall having a fixed geometric relationship, said inner and outer walls forming a channel there between, said channel including a label container area that is accessible by a user for the insertion of a label therein, at least a portion of said outer wall being translucent such that a label placed in said label container area may be read without being removed from said food storage unit;
at least one label support member that is located within said channel and is physically attached to said inner and outer walls, said label support member that prevents a label inserted into said label container area from falling to the bottom of said channel; and
a lid that may be fixably attached to said container top to seal said container CLOSED.

24. (amended) The food storage unit of claim 1, wherein said lid comprises:

stacking support structure that may be engaged with a container bottom of [a] another food storage [container] unit to hold said food storage unit and said another food storage [container] unit in alignment relative to each other.

26. (amended) A food storage unit, comprising:

a container comprising a container top, a container bottom, an inner wall and an outer wall having a fixed geometric relationship, said inner and outer walls forming a channel there between, said channel including a label container area that is in close proximity to said container top, said label container area that is accessible by a user for the insertion of a label therein, at least a portion of said outer wall being translucent such that a label placed in said label container area may be read without being removed from said food storage unit; and

a lid that may be fixably attached to said container top to seal said container CLOSED.